UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,952	12/03/2003	Roy Schoenberg	66729/P033US/10614705	4379

29053   7590   02/10/2009
FULBRIGHT & JAWORSKI L.L.P
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER
PACHURA, REBECCA L

ART UNIT	PAPER NUMBER
2436	

MAIL DATE	DELIVERY MODE
02/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/726,952	SCHOENBERG, ROY
	Examiner	Art Unit	
	Rebecca L. Pachura	2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 November 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-28 and 30-36</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-28 and 30-36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>03 December 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail. Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   **Claims 1-28 and 30-36 are pending in this Office Action.**

      Claim 30 is amended.

      Claim 29 is canceled.

Claim Objections

2.   The objection to claim 29 is withdrawn based on the amendment submitted on

11/26/2008.

Response to Amendment

3.   **The 35 U.S.C. 112, second paragraph rejection on claim 30 is withdrawn based on**

the applicant's amendments submitted on 11/26/2008.

Applicant's Invention as claimed:

Claim Rejections - 35 USC § 102

       The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

   A person shall be entitled to a patent unless –

   (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
   in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
   patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
subsection of an application filed in the United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English language.

4.   **Claims 1-4, 6-10, 13-15, 22-28, 30, 31, 33, and 34 are rejected under 35 U.S.C. 102(e)**

as being anticipated by US 6941271 (Soong).

As to claim 1, (original) Soong discloses a key maintenance method comprising:

maintaining, in a datastore, a first-level access key that grants, to a medical service provider, a

level of access to a set of medical records of a patient (Soong column 2, lines 47-57); retrieving

the first-level access key; and generating a second-level access key by modifying the level of

access of the first-level access key (Soong column 6, lines 14-25 (first level) lines 32-44 (second

level) and lines 56-56, and column 11, lines 6-49).

As to claim 2, (original) Soong discloses the key maintenance method of claim 1

wherein: the levels of access of the first-level and second-level access keys are defined using

one or more access parameters; the set of medical records is a multi-portion medical record; and

the access parameters provide access to one or more portions of the set of medical records

(Soong column 12, lines 16-34).

As to claim 3, (original) Soong discloses the key maintenance method of claim 1 further

comprising transmitting the second-level access key to the medical service provider, wherein the

medical service provider subsequently stores the second-level access key on an MSP key

repository assigned to the medical service provider (Soong column 6, lines 32-49).

As to claim 4, (original) Soong discloses the key maintenance method of claim 1 further

comprising storing the second-level access key in the datastore (Soong column 11, lines 6-49).

As to claim 6, (original) Soong discloses the key maintenance method of claim 4 wherein

the datastore is a patient key repository assigned to the patient (Soong column 11, lines 16-27).

As to claim 7, (original) Soong discloses the key maintenance method of claim 6 wherein the first-level access key was previously-provided to the medical service provider and previously-stored on an MSP key repository assigned to the medical service provider (Soong column 6, lines 32-49).

As to claim 8, (original) Soong discloses the key maintenance method of claim 7 wherein: the patient key repository is a first portion of a centralized key repository; and the MSP key repository is a second portion of the centralized key repository (Soong column 5, lines 14-36).

As to claim 9, (original) Soong discloses the key maintenance method of claim 8 wherein the centralized key repository resides on and is executed by a remote server connected to a distributed computing network (Soong column 5, lines 9-11).

As to claim 10, (original) Soong discloses the key maintenance method of claim 9 wherein: the remote server is a web server; and the distributed computing network is the Internet (Soong column 5, lines 39-42).

As to claim 13, (original) Soong discloses the key maintenance method of claim 1 wherein the second-level access key enhances the level of access of the first level access key, wherein the medical service provider is granted a greater level of access to the set of medical records of the patient (Soong column 11, lines 39-44).

As to claim 14, (original) Soong discloses the key maintenance method of claim 1 wherein the second-level access key reduces the level of access of the first level access key, wherein the medical service provider is granted a reduced level of access to the set of medical records of the patient (Soong column 11, lines 30-39).

As to claim 15, (original) Soong discloses the key maintenance method of claim 1 wherein the second-level access key revokes the level of access of the first level access key, wherein the medical service provider is prohibited from accessing the set of medical records of the patient (Soong column 11, lines 44-49).

As to claim 30, (currently amended) Soong discloses a computer program product (Soong column 4, lines 51-57) residing on a computer readable medium having a plurality of instructions stored thereon which, when executed by ~~the~~ a processor, cause that processor to: maintain, in a datastore, a first-level access key that grants, to a medical service provider, a level of access to a set of medical records of a patient (Soong column 2, lines 47-57); retrieve the first-level access key; and generate a second-level access key by modifying the level of access of the first-level access key (Soong column 6, lines 14-25 (first level) lines 32-44 (second level) and lines 56-56, and column 11, lines 6-49).

As to claims 22-28, 31, 33, and 34, claims 22-28, 31, 33, and 34 (original) encompass the same scope of the invention as those of claims 1-4, 6-10, and 13-15 with the addition of "a server system including a computer processor and associated memory" (Soong column 4, lines 30-42 and column 5, lines 7-12). Therefore, claims 22-28, 31, 33, and 34 are rejected for the same reasons as stated above with respect to claims 1-4, 6-10, and 13-15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 5, 11, 12, 16-21, 32, 35, and 36 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US 6941271 (Soong) in view of US 20040068650 (Resnitzky).

As to claim 5, (original) Soong discloses the key maintenance method of claim 4. Soong

does not explicitly teach further comprising deleting the first-level access key from the datastore.

However, Resnitzky discloses further comprising deleting the first-level access key from

the datastore (Resnitzky page 7, paragraph 0128).

It would be obvious to one of ordinary skill in the art at the time of the applicant's

invention to combine Soong and Resnitzky because Soong teaches multiple databases and

Resnitzky teaches manipulating databases (Resnitzky page 7, paragraph 0128).

As to claim 11, (original) Soong discloses the key maintenance method of claim 7.

Soong does not explicitly teach further comprising reconciling the patient key repository and the

MSP key repository.

However, Resnitzky discloses further comprising reconciling the patient key repository

and the MSP key repository (Resnitzky page 8, paragraphs 0130-0132).

It would be obvious to one of ordinary skill in the art at the time of the applicant's

invention to combine Soong and Resnitzky because Soong teaches multiple databases and

Resnitzky teaches how to reconcile them (Resnitzky page 8, paragraphs 0130-0132).

As to claim 12, (original) Soong discloses the key maintenance method of claim 11.

Soong does not explicitly teach wherein reconciling includes overwriting the first-level access

key stored within the MSP key repository with the second-level access key stored in the patient

key repository.

However, Resnitzky discloses wherein reconciling includes overwriting the first-level access key stored within the MSP key repository with the second-level access key stored in the patient key repository (Resnitzky page 8, paragraphs 0130-0132).

It would be obvious to one of ordinary skill in the art at the time of the applicant's invention to combine Soong and Resnitzky because Soong teaches multiple databases and Resnitzky teaches how to reconcile them (Resnitzky page 8, paragraphs 0130-0132).

As to claims 16-21, 32, 35, and 36, claims 16-21, 32, 35, and 36 (original) encompass the same scope of the invention as those of claims 1-15 with the addition of "a computer program product" (Soong column 4, lines 51-57). Therefore, claims 16-21, 32, 35, and 36 are rejected for the same reasons as stated above with respect to claims 1-15.

Remarks

6.   Applicant has presented amendments for the 35 U.S.C. 112, second paragraph rejection. Applicant has made arguments for the rest of the response, see below.

The Applicant Argues:

Claim 1 recites, in part, "retrieving the first-level access key; and generating a second-level access key by modifying the level of access of the first-level access key" (emphasis added). Soong fails to disclose at least this element of claim 1, as discussed below.

Soong is directly generally to "manipulation and handling of health care records to enhance patient care". Col. 1, lines 8-10. While Soong mentions that access rules may be used for controlling access to the health care records (see e.g., col. 2, lines 50-58 and col. 11, line 6 -

col. 12, line 34), Soong provides no teaching regarding modifying existing access rules. That is, Soong provides no teaching of generating a second-level access key by modifying the level of access of the first-level access key", as recited by claim 1. Instead, Soong is primarily concerned with modification of existing health care records (see e.g., col. 4, lines 60-67, col. 7, lines 7-20, col. 8, lines 31-37, and col. 9, lines 1-21), rather than modification of any access keys that control access to the health care records.

The Office Action cites to col. 11, lines 6-49 of Soong as teaching this element of claim 1 (see page 3 of the Office Action). However, the cited portion of Soong does not make any mention whatsoever of generating a second-level access key by modifying the level of access of the first-level access key. While the cited portion of Soong mentions generally that "persons seeking records are allowed only to access and organize the selective portions of a patient's records" (col. 11, lines 8-10), this simply provides no teaching or hint of generating a second-level access key by modifying the level of access of the first-level access key. Indeed, this portion of Soong makes no mention whatsoever of modifying the access level of an existing access key in order to generate another access key.

At col. 12, lines 11-20, Soong further mentions that a patient may choose to allow different types of access to different groups of persons. However, this portion of Soong also provides no teaching whatsoever of generating a second-level access key by modifying the level of access of the first-level access key. Again, Soong makes no mention whatsoever of modifying the access level of an existing access key in order to generate another access key.

Therefore, Soong fails to teach all elements of claim 1, and thus fails to anticipate the claim under 35 U.S.C. § 102. Accordingly, the rejection of claim 1 should be withdrawn.

In response, the examiner respectfully submits:

That Soong does in fact teach "retrieving the first-level access key; and generating a second- level access key by modifying the level of access of the first-level access key" (Soong column 6, lines 14-25 (first level) lines 32-44 (second level) and lines 56-56, column 11, lines 6-49). Soong states that at the first level of access one must have established the right to access the site computer and at the modified second level it is determines if one has the right to access particular records.

The Applicant Argues:

Claim 22 recites, in part, "wherein the server system is configured to: ... retrieve the first-level access key; and generate a second-level access key by modifying the level of access of the first-level access key" (emphasis added). Soong fails to disclose at least this element of claim 22 for reasons similar to those discussed above with claim 1. Accordingly, the rejection of claim 22 should also be withdrawn.

In response, the examiner respectfully submits:

Please see arguments above.

The Applicant Argues:

Claim 30 recites, in part, "retrieve the first-level access key; and generate a second- level access key by modifying the level of access of the first-level access key" (emphasis added). Soong fails to disclose at least this element of claim 30 for reasons similar to those discussed above with claim 1. Accordingly, the rejection of claim 30 should also be withdrawn.

In response, the examiner respectfully submits:

   Please see arguments above.

The Applicant Argues:

   Dependent claims 17-21 stand rejected under 35 U.S.C. § 102 as being anticipated by

Soong. However, claims 17-21 each depend either directly or indirectly from independent claim

16, and thus inherit all limitations of independent claim 16. The Office Action concedes that

Soong fails to teach all elements of claim 16, see page 9 of the Office Action. Accordingly,

Soong likewise cannot properly anticipate claims 17-21. As such, the rejection of claims 17-21

should be withdrawn, and any new grounds of rejection for these claims should be presented in a

new non-final office action to afford Applicant a full and fair opportunity to consider and

respond to those new grounds of rejection.

In response, the examiner respectfully submits:

   That she inadvertently placed dependent claims 17-21 under the 35 U.S.C. 102 rejection

when they were clearly suppose to be rejected under 35 U.S.C. 103 she apologizes and therefore

is remedying this by issuing a second non-final office action.

The Applicant Argues:

   Each of dependent claims 2-4, 6-10, 13-15, 23-28, 31, 33, and 34 depends either directly

or indirectly from one of independent claims 1, 22, and 30, and thus each inherits all limitations

of the respective independent claim from which it depends. It is respectfully submitted that

dependent claims 2-4, 6-10, 13-15, 23-28, 31, 33, and 34 are allowable not only because of their

dependency from their respective independent claim for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compels a broader interpretation of their respective independent claim).

In response, the examiner respectfully submits:

That dependent claims 2-4, 6-10, 13-15, 23-28, 31, 33, and 34 depend from rejected independent claims 1, 22, and 30 and therefore still stand rejected.

The Applicant Argues:

Claim 16 recites, in part, "retrieving the first-level access key; generating a second- level access key by modifying the level of access of the first-level access key; and deleting the first-level access key from the datastore" (emphasis added). The combination of Soong and Resnitzky fails to teach or suggest at least the above-emphasized element of claim 16, as discussed below.

The Office Action relies on Soong as teaching the above-emphasized element. However, for the reasons discussed above with claim 1, Soong fails to teach or suggest this element of claim 16. Resnitzky is not relied-upon as disclosing this element, nor does it appear to do so.

Therefore, the combination of Soong and Resnitzky fails to teach or suggest all elements of claim 16, and thus fails to render claim 16 unpatentable under 35 U.S.C. §103. Accordingly, the rejection of claim 16 should be withdrawn.

In response, the examiner respectfully submits:

Please see arguments above.

The Applicant Argues:

Each of dependent claims 5, 11, 12, 32, 35, and 36 depends either directly or indirectly

from one of independent claims 1 and 30, and thus each inherits all limitations of the respective

independent claim from which it depends. It is respectfully submitted that dependent claims 5,

11, 12, 32, 35, and 36 are allowable not only because of their dependency from their respective

independent claim for the reasons discussed above, but also in view of their novel claim features

(which both narrow the scope of the particular claims and compels a broader interpretation of

their respective independent claim).

In response, the examiner respectfully submits:

That dependent claims 5, 11, 12, 32, 35, and 36 depend from rejected independent claims

1 and 30 and therefore still stand rejected.

Based on the examiner's arguments claims 1-4, 6-10, 13-15, 22-28, 30, 31, 33, and 34 are

rejected under 35 U.S.C. 102(e) and claims 5, 11, 12, 16-21, 32, 35, and 36 are rejected under

35 U.S.C. 103(a).

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Rebecca L. Pachura whose telephone number is (571) 270-3402.

The examiner can normally be reached on Monday-Thursday 10:00 am-8:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rebecca L Pachura/
Examiner, Art Unit 2436

/Nasser G Moazzami/
Supervisory Patent Examiner, Art Unit 2436